

In re application of : NEFF et al.

Page 12 of 15

Application No. : 10/086,116

Filing Date : February 26, 2002

Examiner : Akintola, Olabode

Title : Electronic Bartering System with Facilitation Tools

REMARKS

Applicants wish to thank Examiner Akintola for the consideration given to this case to date. In particular, Applicants wish to thank Examiner Akintola for his helpful assistance during the telephone interview of April 10, 2009. Applicants have carefully considered the January 15, 2009 Office Action, and respectfully submit that the subject application is in condition for allowance based upon the amendments presented herein and the following remarks.

The Office Action set a shortened statutory period for response of three (3) months to expire on April 15, 2009. This Amendment and Response to January 15, 2008 Office Action ("Response") is being filed or transmitted on April 15, 2009. Therefore, this paper is timely filed

Summary of April 10, 2009 Telephone Interview

On April 10, 2009, Examiner Akintola and the undersigned attended a telephone interview to discuss the subject application. The examiner and the undersigned discussed claim 1 and the differences between the subject application and the system of Ojha. Specifically, the undersigned explained that Ojha does not disclose "describing the order," "no symbols specified," and "generating a contra order." The Examiner provided helpful suggestions regarding this Response which have been incorporated herein. No agreement on patentability was reached at that time, but the Examiner agreed to consider the substance of the interview along with this Amendment.

Status of Claims

The subject application was originally filed with claims 1-135. Claims 27-135 were canceled by amendment on December 7, 2005. Claims 136-141 were added during prosecution. In this Amendment, Applicants have amended claims 1-26 and 136-141, and added new claims 142-144. Accordingly, claims 1-26 and 136-144 remain pending in the subject application.

In re application of : NEFF et al.
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Page 13 of 15

Summary of Office Action

In the January 15, 2009 Office Action, the Examiner:

- (1) rejected claim 13 under 35 U.S.C. § 101 because the invention is directed to non-statutory subject matter;
- (2) rejected claims 1-26, 136 and 138 under 35 USC § 103(a), as being unpatentable over Nieboer et al (USPN 6,418,419) in view of Ojha et al (USPN 6,598,026); and
- (3) rejected claims 137, 139, 140 and 141 under 35 USC § 103(a), as being unpatentable over USPN 6,418,419 (“Nieboer”) in view of USPN 6,598,026 (“Ojha”) and further in view of Santoli (“The Striking Price: Some Option,” Barron’s, New York, NY.: Aug. 23, 1999. Vol. 79, Issue 34, page MW13).

Correction of Continuity Data

Applicants note that the continuity data provided by the PAIR system is not completely correct. The PAIR system correctly indicates that the subject application claims priority under 35 USC §119(e) to US Provisional Application No. 60/271,541 filed on February 26, 2001. The PAIR system, however, fails to indicate that the subject application also claims priority to US Patent Application No. 09/454,035 filed on December 3, 1999, US Provisional Application No. 60/161,318 filed on October 25, 1999, US Provisional Application No. 60/153,142 filed on September 9, 1999, and US Provisional Application No. 60/147,243 filed on August 5, 1999. The claim of priority was correctly identified on page 1 of the specification filed on February 26, 2002. Appropriate correction of the continuity data of the PAIR system is respectfully requested.

Rejection of Claim 13 Under 35 U.S.C. § 101

Claim 13 stands rejected under 35 U.S.C. § 101 because the invention is directed to non-statutory subject matter. Applicants have amended claim 13 to recite a “method operable on a computer for responding to order flow” (emphasis added) thereby bringing claim 13 in compliance with the subject matter requirement of 35 U.S.C. § 101.

In re application of : NEFF et al.

Page 14 of 15

Application No. : 10/086,116

Filing Date : February 26, 2002

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Title : Electronic Bartering System with Facilitation Tools

Rejection of Claims 1-26 and 136-141 Under 35 U.S.C. § 103(a)

Claims 1-26, 136 and 138 stand rejected under 35 USC § 103(a) as being unpatentable over Nieboer in view of Ojha. Claims 137, 139, 140 and 141 stand rejected under 35 USC § 103(a), as being unpatentable over Nieboer in view of Ojha and further in view of Santoli. Applicant submits that amended claims 1-26 and 136-141, as well as new claims 142-144, are allowable over the combination of Nieboer, Ojha, and Santoli. Applicants expressly reserve the right to prosecute the claims as originally presented.

Applicants submit that the Office fails to establish a *prima facie* case of obviousness. MPEP §2143.03 reads:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) . . . If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

In the subject application, Applicant respectfully submits that several aspects of the invention are not taught or suggested by Nieboer, Ojha or Santoli.

Specifically, none of the cited references teaches or suggests “automatically generating a contra order in response to the order.” Ojha discloses automatical responses to bids, such as the lowering of an asking price for a product in an electronic commerce application (see Ojha at col. 7, lines 35-58), but that is not the same as automatically generating a contra order in a stock trading system.

Further, none of the cited references teaches or suggests employing rule with no symbols specified and a characteristic “describing the order” (see subject application at paragraphs 244, 251, 255, 279, 299 and 310). In Ojha, the identified characteristics do not describe an order. Rather, the characteristics of Ojha describe either the product (Fig. 13C) or the purchaser (Fig. 13D).

Accordingly, for at least the reasons stated above, Applicants contend that independent claims 1, 7, 13-15, 20, 25, 26 and 142 are patentable over Nieboer in view of Ojha, and that they are in condition for allowance. Further, Applicants contend that dependent claims 2-6, 8-12, 16-

In re application of : NEFF et al.

Page 15 of 15

Application No. : 10/086,116

Filing Date : February 26, 2002

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19, 21-24, 136-141 and 143-144 are patentable for the same reasons as the independent claims from which the depend. Consequently, Applicants respectfully request the Examiner allow claims 1-26 and 136-144.

CONCLUSION

In view of the remarks above and the amendments presented herein, it is believed that claims 1-26, and 136-144 are in condition for allowance and notice to such effect is respectfully requested. Applicants request that the Examiner contact the undersigned at the phone number below for a telephone interview prior to issuing another Office Action in order to expedite prosecution of the subject application.

Respectfully submitted,

Dated: April 15, 2009

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